REMARKS

A. Brief Status of the Claims

Claims 15-19 and 24-33 were pending in the application when the Office Action was issued. Claims 15-19 and 24-33 were rejected under 35 U.S.C. § 103(a). Claims 15 and 24 have been amended and claims 17 and 26 have been cancelled. Claims 15-16, 18-19, 24-25 and 27-33 remain pending in the application.

B. Rejection of Claims 15-19 and 24-33 Under 35 U.S.C. § 103(a)

Claims 15-19 and 24-33 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over U.S. Patent No. 6,463,421 to Junger ("the Junger patent") in view of U.S. Patent No. 6,536,659 to Hauser et al.

A proper *prima facie* case of obviousness requires, among other things, that the combined prior art references must teach or suggest all of the claim limitations. MPEP § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03; In re Wilson, 424 F. 2d. 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Because, as explained in more detail below, the Office Action does not explain how all of the subject matter recited in the amended claim 15 is purportedly either disclosed or rendered obvious by Junger and/or Hauser, Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness with respect to the subject matter recited in amended independent claim 15.

For example, amended independent claim 15 recites, among other things, a method for remanufacturing cores into remanufactured items, "updating the data stored on the memory

device by applying the credit **for the core associated with the sale of the later-sold remanufactured item against the earlier core liability…"** (emphasis added)

The Examiner concedes that the Junger patent "does not disclose determining an amount of credit available for returning the core associated with the sale of the later-sold remanufactured item, the amount being based upon the inspection; and which to updating the data stored on the memory device by applying the credit for the core associated with the slae of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the slae of the earlier-sold remanufactured item paid on sale of the item associated with the return." Office Action at 3. In an effort to remedy this acknowledged deficiency of Junger, the Examiner asserts that the Hauser patent discloses "that the method having [sic] determining an amount of credit available for returning the core associated with the sale of the later-sold remanufactured item, the amount being based upon the inspection" id. at 3; and which to "updating the data stored on the memory device by applying the credit **for the core associated with the sale of the later-sold remanufactured item against the earlier core liability**, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item paid on sale of the item associated with the return" id. at 4 (emphasis added).

The Junger patent admittedly does not teach all of the elements of the claimed concepts and Hauser simply does not assist in rendering the present disclosure, obvious. The Hauser patent dicloses a method for handling goods returned by customers of a plurality of different merchants, Hauser, abstract.

By incorporating a method of remanufacturing cores into remanufactured items, comprinsing the steps of "providing a total price for the remanufactured items, the total price

incluiding at least a refundable core deposit and a remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture, establishing an earlier entitlement corresponding an earlier core liability having an amount equal to the core deposit paid with the total price of the earlier sold core, and canceling the earlier entitlement after return of the core associated with the later-sold remanufactured item, Applicant has discoved and addressed problems different from problems likely to be encountered, and solved, by one of ordinary skill in the art of Junger in view of Hauser. There is nothing of record to indicate that Junger's mere disclosure of handling of product returns using a printer to print labels to place on packaging for the returned products, and using a computer sustem to scan the returned products represnts anything other than conventional wisdom, i.e. identifying information – and there is no teaching, suggestion or motivation to suggest otherwise (Junger, abstract and col 8, lines 53-64).

In light of the claim amendments, and as discussed above, we assert that the present application is not obvious in view of the Junger patent, therefore the rejections based on obviousness must be withdrawn. Junger flatly fails to explicitly, implictly or inherently teach the method, as amended and presented in the present claims. Dependent claims 15-16, 18-19, 24-25 and 27-33 should be allowable, at the least, by virtue of their dependency from independent claims 15 and 24, respectively. "If an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03. However, the dependent claims of the present application have additional elements that further differentiate them fom the cited prior art.

For all of these reasons, Applicants respectfully assert that the rejection of claims 15, 24 and 29 and their dependent claims (see MPEP § 2143.03) were in error, and urge the Office to withdraw these rejections. Applicants respectfully submit that claims 15-16, 18-19, 24-25 and 27-33 are allowable over the Junger patent in view of Hauser.

C. Conclusion

Applicant respectfully submits that each of the grounds of rejection set forth in the Office Action has been answered herein and favorable reconsideration is earnestly solicited. We respectfully submit that the application is in condition for allowance. If, however, the Office concludes that there are any remaining issues to be resolved before the application can be allowed, the Office is invited to contact the undersigned representative via telephone to discuss an expeditious resolution.

The Office Action set a shortened statutory three-month period for reply expiring on August 28, 2009. This reply is being submitted outside of this time period, therefore, respectfully, a three-month extension of time fee is believed to be due. No other fees are believed due at this time. However, any fees that are due for the submission of this reply may be charged to the undersigned's deposit account no. 03-1129. Additionally, please grant any extensions of time required to enter this response.

Respectfully submitted,

Date: 24-November-2009

By: /Janda M. Carter/

Jandá M. Carter
Registration No. 58,033
Caterpillar Inc.
Tel.: (309) 675-1556
Fax: (309) 675-1236